

REMARKS

Claims 1, 2, 13, 18, 19 and 22 have been amended. Support for the amendments may be found in FIG. 1 and page 11 of the specification. Claims 1-9, 11-14, 16-23 are currently pending in the present application. No new matter has been added. Reexamination and reconsideration of the application are respectfully requested.

REJECTION OF CLAIMS 1-9, 11-14, 16, 18-23 UNDER 35 U.S.C. 103(a)

Claims 1-9, 11-14, 16, 18-23 are rejected under 35 U.S.C. 103 for the reasons set forth on pages 4-6 of the Action. Specifically, claims 1-9, 11-14, 16, 18-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walsh et al. (U.S. Pat. No. 5,870,617, hereinafter referred to as “Walsh” or “the Walsh reference”) in view of Hidehiko et al. (JP 06052070A, hereinafter referred to as “Hidehiko” or “the Hidehiko reference”).

With respect to claims 1, 5, 13 and 18, it is the Action’s position that Walsh teaches all the claimed elements except the “state save being a scan-based state save.” Hidehiko is cited for teaching the use of a “scan-based state-save and restore of data in a circuit upon power source discontinuation.” The Action then states “it would have been obvious to a person of ordinary skill in the art at the time of the invention to use a scan-based state-save as the state save in Walsh because this would have provided a fast method of data evacuation.”

The rejections under 35 U.S.C. 103 are respectfully traversed, at least insofar as applied to the amended claims, and reconsideration and reexamination of the application is respectfully requested for the reasons set forth hereinbelow. This

combination is contested as improper for the reasons advanced below. However, even if this combination were proper, which is not conceded, the resulting combination would still fail to teach or suggest the claimed invention.

Specifically, Walsh, whether alone or in combination with Hidehiko, fails to teach or suggest “a selection unit that includes a first input for receiving signals from a source external to the circuit, a second input for receiving signals from the inactive state power reduction manager, a control input for receiving a save-state mode signal, and an output that is coupled to the scan circuitry,” “performing a state save by employing the scan circuitry and a selection unit that includes a first input for receiving signals from a source external to the circuit, a second input for receiving signals from an inactive state power reduction manager, a control input for receiving a save-state mode signal, and an output that is coupled to the scan circuitry,” and “a selection unit that includes a first input for receiving signals from a source external to the circuit, a second input for receiving signals from the inactive state power reduction manager, a control input for receiving a save-state mode signal from the inactive state power reduction manager, and an output that is coupled to the test access port,” as claimed in claims 1, 13, and 18, respectively.

The components of Walsh and Hidehiko do not fairly teach or suggest these claimed limitations. It is noted that the dependent claims incorporate all the limitations of independent claims 1, 13, and 18, respectively. Furthermore, the dependent claims also add additional limitations, thereby making the dependent claims a fortiori and independently patentable over the cited references.

For example, dependent claims 21-23 recite limitations related to receiving a wake-up signal; responsive to the wake-up signal, re-connecting the switched power portion of the circuit to power; g) performing a state restore by employing the scan circuitry; and h) re-starting the normal mode clock. These limitations do not appear to be taught or suggested by the Walsh and Hidehiko references.

Furthermore, it is respectfully submitted that the Walsh and Hidehiko references are improperly combined. It appears that the Action uses improper hindsight to selectively pick teachings from Walsh and teachings from Hidehiko to arrive at the claimed invention. For example, it appears that the current patent application has been improperly used as a basis or template for the motivation to combine or modify the components selected from Walsh and Hidehiko to arrive at the claimed invention. Stated differently, the proposed combination of the cited references appears to be based on impermissible hindsight reconstruction.

The Federal Circuit has held, “It is impermissible to use the claimed invention as an instruction manual or “template” to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated, “[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.” (quoting *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988)), *In re Fritch*, 23 USPQ 2d 1780, 1784 (Fed. Cir. 1992). [emphasis added.]

In view of the foregoing, it is respectfully submitted that the Walsh reference, whether alone or in combination with the Hidehiko reference, fails to teach or suggest

the circuit, method, and circuit board as claimed. Accordingly, it is respectfully requested that the claim rejections under 35 U.S.C. Section 103(a) be withdrawn.

Conclusion

For all the reasons advanced above, it is respectfully submitted that the application is in condition for allowance. Reexamination and reconsideration of the pending claims are requested, and allowance is earnestly solicited at an early date. The Examiner is invited to telephone the undersigned if the Examiner has any suggestions, thoughts or comments, which might expedite the prosecution of this case.

Respectfully submitted,

Eric Ho

Dated: Nov. 8, 2005

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Eric Ho
Eric Ho (RN 39,711)

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(Date)